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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,673	02/22/2002	Ronald Wetzel	HME/7477.014	3069

29085 7590 05/17/2005

HOWARD EISENBERG, ESQ.
2206 APPLEWOOD COURT
PERKASIE, PA 18944

EXAMINER

CHEU, CHANGHWA J

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,673

Applicant(s)

WETZEL ET AL.

Examiner

Jacob Cheu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) 13-20, 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-26 and 50-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's amendment filed on 2/4/2005 has been received and entered into record and considered.

The following information provided in the amendment affects the instant application:

1. Claims 1-12, 30-49 are cancelled.
2. Claim 51 is added to the instant application.
3. Claims 21-26, 50-53 are under examination. Claims 13-20, 27-29 are withdrawn from further consideration.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 21-26, 50-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 21, line 3, "diameter of less than 10 nm and a length of less than 100 nm" is vague and indefinite. It is not clear about the metes and bounds of the recited filament. For instance, "less than" could be zero in diameter and length. Applicant needs to specify.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-22, 24-26, 50-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Schezinger et al. (Cell Vol. 90, page 549).

Schezinger et al. teach constructing proteins containing polyglutamine repeats for study of neurodegeneration disease. The proteins constructed by Schezinger et al., for instance GST-HD51 (containing polyglutamine repeats) has dimensions of diameter of 6-7 nm and length less 100 nm or 60 nm (See Figure 4a). The other trypsin-treated filament has diameter of 7.7 nm and less than 100 nm (See Figure 4d; Note the arrow area where the length is less than 100 nm or 60 nm).

With respect to claim 26, Schezinger et al. teach using 20 polyglutamine repeats (See Experimental Procedure, page 556).

With respect to claims 50-53, applicant recites process of making the product, i.e. freezing the solution containing peptides, incubating the frozen peptides to permit aggregates, sonication. The production of a product by a particular process does not impart novelty or unobviousness to a product when the same product is taught by the prior art. This is particularly true when the properties of the product are not changed by the process in an unexpected manner. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972). Therefore, even if a particular process used to prepare a product is novel and unobvious over the prior art, the product per se, even when limited to the particular process, is unpatentable over the same product taught by the prior art. See In re Kind, 207 F.2d 618, 620, 43 USPQ 400, 402 (CCPA 1939); In re Merz, 97 F.2d 599, 601, 38 USPQ 143, 144-145 (CCPA 1938); In re Bergy, 563 F.2d 1031, 1035, 195 USPQ 344, 348 (CCPA 1977) *vacated* 438 U.S. 902 (1978); and United States v. Ciba-Geigy Corp., 508 F. Supp. 1157, 1171, 211 USPQ 529, 543 (DNJ 1979).

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5. Claims 21-26, 50-53 are rejected under 35 U.S.C. 102(a) as being anticipated by Chen et al. (Protein Science 2001, Vol. 10, pages 887).

Chen et al. teach a method of chemical dissolving and disaggregating of polyglutamine repeats peptides in vitro. Although Chen et al. do not report the dimension of the synthesized polyglutamine peptides, nevertheless Chen et al. use the same methodology as disclosed in the specification and recited in claims 50-53 by the applicant, such as same ratio (1:1) of trifluoroacetic acid (TFA) and hexafluoroisopropanol (HFIP), sonication and incubating in a frozen condition (See left column, page 890, last paragraph to the first paragraph of right column). It would be inherent that the diameter and length of the polyglutamine filament synthesized by the Chen et al. would possess the similar dimensions as recited in the claim.

With respect to claim 26, Chen et al. use polyglutamine repeats, from 15-35, for synthesis of filament (See page 888, right column, first paragraph).

Response to Applicant's Arguments

6. Applicant's arguments with respect to claims 21-26, 50-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. No claim is allowed.

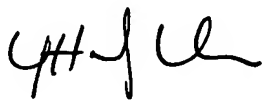
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 571-272-0814. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacob Cheu



Examiner

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May 12, 2005



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

05/13/05